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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,049	03/30/2001	Keisei Yamamuro	2001-0375A	5127

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WENDEROTH, LIND & PONACK, L.L.P.  
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WASHINGTON, DC 20006-1021

EXAMINER

PARRA, OMAR S

ART UNIT	PAPER NUMBER
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2623

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/27/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

**Application No.**

09/821,049

**Applicant(s)**

YAMAMURO ET AL.

**Examiner**

Omar Parra

**Art Unit**

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 16 October 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7, 14 and 16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7, 14 and 16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date See Continuation Sheet.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

Continuation of Attachment(s) 3. Information Disclosure Statement(s) (PTO/SB/08), Paper No(s)/Mail Date :03/21/2002-01/29/2003-03/14/2005-03/01/2006-06/14/2006.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/16/2006 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 7, 14 and 16 have been considered but are moot in view of the new ground(s) of rejection.

In response to applicant's arguments on pages 4-10 of the 10/16/2006 Remarks, the newly added limitations "accepting program related information as a user input and determining whether or not the program related information inputted by the user matches program related information supplied from a provider of the program contents" (claims 7, 14 and 16) are still met by Holman and McCollum as described below.

In response to applicant's arguments,

(Page 13, ¶ 6 and page 14, ¶ 2), stating that McCollum, similar to Holman, does not disclose or suggest in input acceptor (Holman's 'front panel keyboard 5', fig. 1 or

'remote control device 43', Fig. 2) (col. 6, lines 8-9 & 25-26; col. 8, lines 51-54; col. 5, lines 54-55) for accepting program related information as a user input, and determining whether or not the program related information inputted by the user matches program related information supplied from a provider of the program content, and

(Page 14, ¶ 3), stating that McCollum, similar to Holman, does not disclose or suggest a viewing information recorder for recording, (Holman, home unit 1 comprises a viewed commercial/coupon recorder –fig. 2) on a removable recording medium (Holman, smart/ "Q-Card" card or coupon printer paper), viewing information having the program identifier to identify the program contents (Flag placed to selected coupons when 'MARK' button is pressed for subsequent storing, Holman, col. 13 lines 7-40) when the input acceptor determines that the program related information inputted by the user matches the program related information supplied from the provide of the program contents (col.6 lines 5-38 and col.9 lines10-32), the examiner respectfully disagrees.

McCollum, on the other hand, teaches being able to accept user inputted program related information and determining whether or not the program related information inputted ('store name, catalog description, keywords, and/or text description' [0108] lines 17-18) matches some program related information supplied ([0108] lines 15-24). It is the searching feature using program related information (store name, catalog description, keywords, and/or text description) and the determination of whether or not the program related information matches some information being searched (Holman's saved list of coupons) what is being included in Holman's invention to cover the claimed limitations.

Therefore, the examiner respectfully believes that the combination of Holman and McCollum's teachings cover all the limitations of the applicant's invention as claimed.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7, 14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holman (Patent No. 5,287,181) in view of McCollum et al. (Pub. No. 2002/0010623).

Regarding claims 7, 14, and 16, Holman teaches a system (and corresponding method and computer instructions) with a receiver (home unit 1 - fig. 1) comprising:

a program acceptor (cable box 33 - fig. 2) for accepting program contents (commercial logos or emblems 40 - fig. 2), and program information having a program identifier to identify program contents (commercial message information) (col. 6, lines 5-12; col. 8, lines 5-7; col. 9, lines 33-37; col. 9, lines 56-58; col. 11, lines 12-17 & lines 5-60; col. 15, line 55 & fig. 5; col. 14, lines 35--36).

a display 3 (fig. 1) unit for displaying the program contents (40 - fig. 2);

Art Unit: 2623

an input acceptor for accepting a user input (front panel keyboard 5 -fig. 1, e.g., coupon button 11 - fig. 1 or remote control device 43 - fig. 2) (col. 6, lines 8-9 & 25-26; col. 8, lines 51-54; col. 5, lines 54-55); and

a viewing information recorder (home unit 1 comprises a viewed commercial/coupon recorder- fig. 2) for recording, on a removable recording medium (smart/"Q-Card" card or coupon printer paper), viewing information having the program identifier to identify the program contents (Flag placed on coupons once the user identifies a desired one when 'MARK' button is pressed for subsequent storing, -col. 13 lines 7-40) from program related information supplied from the provider of the program content (col.6 lines 5-38 and col.9 lines10-32). On the other hand, Holman does not explicitly teach that the input acceptor accepts program related information inputted by the user that matches program related information supplied from a program provider.

However, in an analogous art, McCollum teaches being able to accept user inputted program related information and determining whether or not the program related information inputted ('store name, catalog description, keywords, and/or text description' [0108] lines 17-18) matches some program related information supplied or stored ([0108] lines 15-24).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of Holman to include the input acceptor accepts program related information inputted by the user that matches program related information supplied from a program provider as taught by McCollum for the added advantage of increasing user convenience and more

Art Unit: 2623

efficiently/quickly/easily searching the database of obtained coupons (Holman - col. 12, lines 56-59).

**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Parra whose telephone number is 571-270-1449. The examiner can normally be reached on Under Academy Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Grant can be reached on 571-272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OP



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